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Date: September 14, 2006

Signature: \_\_\_\_\_

(Quyen Nguyen)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 09/095,323

Confirmation No.: 9521

Filing Date: June 10, 1998

Inventor(s): Michael D. LAUFER

Title: METHOD AND APPARATUS FOR TREATING SMOOTH  
MUSCLES IN THE WALLS OF BODY CONDUITS

Examiner: D. Shay

Group Art Unit: 3739

**RESPONSE TO FINAL OFFICE ACTION**

Mail Stop AF  
Commissioner for Patent  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the final Office Action dated June 12, 2006 for which a response was due on September 12, 2006. Filed herewith is a Petition and fee for a one-month extension of time, thereby extending the deadline for response to October 12, 2006. Accordingly, this response is timely filed. Reconsideration and allowance of the pending claims, as amended, in light of the Remarks presented herein are respectfully requested.

**Amendments to the Claims** are reflected in the listing of claims which begins on page 2 of this paper.

**Remarks** begin on page 4 of this paper.

## AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions, and listings, of claims in the application:

**In the claims**

1.-27. (cancelled)

28. (currently amended): The method of claim 50, wherein said irradiating step is performed by irradiating smooth muscle tissue in an asthmatic lung.

29. (previously presented): The method of Claim 28, wherein said irradiating step is performed by emitting a light energy having a wavelength of about 240 nm to about 280 nm.

30. (previously presented): The method of Claim 28, wherein said irradiating step is performed by emitting light energy having a wavelength in the red visible range.

31. (previously presented): The method of Claim 28, wherein said irradiating step is performed by exposing the walls to radiation emitted by a radioactive pellet.

32. (previously presented): The method of Claim 28, wherein said irradiating step is performed by moving an energy delivery device along the airway.

33. (currently amended): A method for treating a-lung asthma comprising the steps of:

providing a source of energy; and

irradiating [[the]] walls of an airway with the energy at a wavelength and intensity sufficient to cause debulking over time in mucus gland cells and preventing the mucus gland cells from replicating.

34. (original): The method of Claim 33, wherein said irradiating step is performed by emitting a light energy having a wavelength of about 240 nm to about 280 nm.

35. (original): The method of Claim 33, wherein said irradiating step is performed by emitting light energy having a wavelength in the red visible range.

36. (original): The method of Claim 33, wherein said irradiating step is performed by exposing the walls to radiation emitted by a radioactive pellet.

37. (original): The method of Claim 33, wherein said irradiating step is performed by moving an energy delivery device along the airway.

38. – 49. (cancelled)

50. (currently amended): A method of treating ~~lung-tissue~~ asthma to relieve asthmatic symptoms, the method comprising:

providing a source of energy; and

irradiating ~~[[the]]~~ walls of an airway of ~~[[the]]~~ a lung with the source of energy at a wavelength and intensity which, over time, causes debulking of tissue of the lung ~~tissue~~ and prevents the lung tissue from replicating.

51. (cancelled)

**REMARKS**

Claims 1-37 and 48-50 were pending in the present application. Claims 1-27, 48 and 49 are cancelled without prejudice pursuant to a restriction requirement. Applicant requests the right to pursue these inventions in a subsequent filing. By virtue of this response, claims 28, 33 and 50 are amended. Support for these amendments may be found throughout the application as filed (see for example, page 3, lines 22-27; page 4, lines 7-10; page 5, lines 13-26, and page 6, lines 4-6 and lines 24-31).

Accordingly, claims 28-37 and 50 are currently pending under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. No new matter has been added.

**Interview Summary**

Applicant's attorney wishes to express gratitude to the Examiner for the telephone interviews of September 6, and September 13, 2006. The participants included applicant, Nena Bains, applicant's representative, Sanjay Bagade and Examiner Shay.

No exhibit was shown.

At this interview, the parties discussed the rejections of independent claims 33 and 50 in view of the final Office Action.

In order to further clarify the subject claims and expedite prosecution, applicant amended claims 33 and 50 to more clearly distinguish the subject claims over the references cited in the Office Action. The parties agreed that amended claims 33 and 50 overcame the current rejections and are in condition for allowance subject to an additional search by the Examiner.

**Rejections under 35 U.S.C. §102(b)**

Claims 50-68 are rejected under 35 U.S.C. §102(b) as being anticipated by Doi in view of Kuth et al.

Applicant and the Examiner agreed that the Office Action's reference to claims 50-68 is a typographical error. The Examiner confirmed that claim 50 alone is rejected under 35 U.S.C. §102(b).

Applicant disagrees that Doi anticipated claim 50 prior to the amendment made herein. However, as the parties agreed, Doi fails to anticipate claim 50 as amended

In view of the above, applicant believes that claim 50 and all claims ultimately dependent therefrom are in condition for allowance.

**Rejections under 35 U.S.C. §103(a) - I**

Claims 28 and 50 are rejected under 35 U.S.C. §103(a) as being unpatentable over Doi in view of Kuth et al.

Once again, applicant disagrees that the Office Action established a proper prima facie case of obviousness with respect to claim 28 or 50. However, the parties agreed that the amendment to claim 50 overcomes this rejection.

In view of the above, applicant believes that claims 50 and 28 (dependent therefrom) are in condition for allowance.

**Rejections under 35 U.S.C. §103(a) - II**

Claims 29-32 are rejected under 35 USC §103(a) as being unpatentable over Doi in view of Kuth et al as applied to claims 28 and 50 (as noted above) and further in combination with Clarke in combination with Waksman et al.

Applicant maintains its disagreement with the above rejection.

As noted above, the amendment to claim 50 overcomes the rejection of Doi in view of Kuth. Accordingly, since claims 29-32 ultimately depend from claim 50, applicant believes this rejection is overcome.

**Rejections under 35 U.S.C. §103(a) - II**

Claims 33-37 are rejected under 35 USC §103(a) as being unpatentable over Clarke in combination with Waksman et al.


Applicant maintains its disagreement with the above rejection. However, as the parties agreed, claim 33 as amended overcomes this rejection.

In view of the above, applicant believes that claim 33 and all claims ultimately dependent therefrom are in condition for allowance.

### CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections and pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Sanjay S. Bagade", is written over a horizontal line.

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